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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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MANELLI DENISON & SELTER
2000 M STREET NW SUITE 700
WASHINGTON, DC 20036-3307

EXAMINER

MOLINARI, MICHAEL J

ART UNIT	PAPER NUMBER
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2665

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/691,913

Applicant(s)

FAROOQ, RIZWAN M.

Examiner

Michael J Molinari

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 10 is objected to because of the following informalities: The word "wherein" is repeated in line 1 of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites the limitation "includes second converting the network data", which is indefinite because it cannot be determined whether it is a second instance of the previous claim limitation "converting the test data" or if it constitutes a completely new claim limitation.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3 and 5-9 are rejected under 35 U.S.C. 102(e) as being anticipated by McRobert et al. (U.S. Patent Application Publication US 2002/0146043).

6. Referring to claim 1, McRobert et al. disclose a method in an integrated test device (see paragraph 0022 which teaches integrating the components on a single chip), the method comprising: performing, using network logic on the integrated test device, first network device operations on received data (see paragraph 0019) and outputting network data according to a media independent interface (MII) based protocol (see paragraph 0022); performing prescribed test operations on the network data using first test logic on the integrated test device (see paragraph 0003 and note that repeaters perform test operations to determine timing and amplitude degradation of the packets) and outputting test data based on the MII-based protocol (see paragraph 0022); and converting the test data into analog-based signals for transmission on a prescribed network medium using second test logic on the integrated test device (converting the rate of the data, see paragraph 0024 and see paragraph 0005).

7. Referring to claim 2, McRobert et al. disclose that the step of performing first network device operations includes switching the received data according to prescribed switching logic (see Figure 1, #10).

8. Referring to claim 3, McRobert et al. disclose that the step of performing prescribed test operations includes second converting the network data, having a first data rate, into the test data having a second data rate substantially greater than the first data rate (see paragraph 0024).

9. Referring to claim 5, McRobert et al. disclose that the converting step includes converting the test data into 10 Base-T compliant analog signals (see paragraph 0024).

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10. Referring to claim 6, McRobert et al. disclose that the converting step includes converting the test data into 100 Base compliant analog signals (see paragraph 0024).
11. Referring to claim 7, McRobert et al. disclose an integrated network test device (see paragraph 0022 which teaches integrating the components on a single chip) comprising: network logic configured for performing prescribed network device operations (see paragraph 0019) and outputting network data based on a media independent interface (MII) based protocol (see paragraph 0022); first test logic configured for performing prescribed test operations on the network data (see paragraph 0003 and note that repeaters perform test operations to determine timing and amplitude degradation of the packets) and outputting test data based on the MII-based protocol (see paragraph 0022); and second test logic configured for converting the test data (converting the rate of the data, see paragraph 0024), output from the first test logic according to the MII-based protocol (see Figure 2), into analog-based signals for transmission on a prescribed network medium (see paragraphs 0005 and 0024).
12. Referring to claim 8, McRobert et al. disclose that the second test logic is configured for converting the test data into 10 Base-T compliant analog-based signals (see paragraph 0024).
13. Referring to claim 9, McRobert et al. disclose that the second test logic is configured for converting the test data into 100 Base compliant analog-based signals (see paragraph 0024).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over McRobert et al. (U.S. Patent Application Publication US 2002/0146043) in view of Mahany et al. (U.S. Patent No. 5,657,317).

16. Referring to claim 4, McRobert et al. disclose that the second data rate is about 10 Mbps but differ from claim 4 in that they fail to disclose that the first data rate is about 250 kbps. However, 250 kbps is a well-known standard data rate in data communication. For example, Mahany et al. teach the use of the 250 kbps data rate, which has the advantage of being a standard data rate in data communication (see column 22, lines 52-55). One skilled in the art would have recognized the advantage of using the 250 kbps data rate as taught by Mahany et al. Therefore, it would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate the use of the 250 kbps data rate as taught by Mahany et al. into the invention of McRobert et al. to achieve the advantage of providing a standard data rate.

17. Referring to claim 10, McRobert et al. disclose that the first test logic is configured for converting the network data to the test data having a second data rate of about 10 Mbps. McRobert et al. differ from claim 10 in that they fail to disclose that the first data rate is about 250 kbps. However, 250 kbps is a well-known standard data rate in data communication. For example, Mahany et al. teach the use of the 250 kbps data rate, which has the advantage of being a standard data rate in data communication (see column 22, lines 52-55). One skilled in the art would have recognized the advantage of using the 250 kbps data rate as taught by Mahany et al. Therefore, it would have been obvious to a person with ordinary skill in the art at the time of the

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invention to incorporate the use of the 250 kbps data rate as taught by Mahany et al. into the invention of McRobert et al. to achieve the advantage of providing a standard data rate.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

19. U.S. Patent No. 5,946,301 to Swanson et al. teaches the advantage of using 10-Base T and 100 Base Ethernet.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Molinari whose telephone number is (703) 305-5742.


The examiner can normally be reached on Monday-Thursday 8am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on (703) 308-6602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Michael Joseph Molinari

**DUCHO
PRIMARY EXAMINER**


5-28-04